

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed on August 25, 2006 (the "Office Action"). Claims 1-30 are pending in the application and stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

The Claims are allowable over *Feeney* even in view of the other cited art

The Office Action rejects the claims under 35 U.S.C. §103(a);

- Claims 1-5, 8-16, 18, and 29 as being unpatentable over U.S. Patent Application Publication No. 2002/0032582 to *Feeney, Jr. et al.* ("*Feeney*") in view of U.S. Patent No. 6,549,956 to *Bass et al.* ("*Bass*") in further view of U.S. Patent Application Publication 2002/0169637 to *Akers* ("*Akers*");
- Claims 19-20, 22-23, and 27-28 as being unpatentable over *Feeney* in view of U.S. Patent Application Publication No. 2003/0093321 to *Bodmer et al.* ("*Bodmer*") in further view of Patent Application Publication No. 2003/0093307 to *Renz et al.* ("*Renz*") and in further view of *Akers*;
- Claims 6 and 17 as being unpatentable over *Feeney* in view of *Bass* in view of *Akers*, as applied to Claims 1 and 13, and in further view of U.S. Patent Application Publication No. 2002/0052760 to *Munoz et al.* ("*Munoz*");
- Claim 7 as being unpatentable over *Feeney* in view of *Bass* in view of *Akers* and in further view of PDXinc.com;
- Claim 21 as being unpatentable over *Feeney* in view of *Bodmer*, *Akers* and *Renz*, as applied to Claim 20, and in further view of U.S. Patent No. 6,049,787 to *Takahashi et al.* ("*Takahashi*"); and
- Claims 24 and 30 as being unpatentable over *Feeney* in view of *Akers* and in further view of U.S. Patent Application Publication No. 2002/0038258 to *Bergman* ("*Bergman*").

Applicants submit that *Feeney* -- even in view of the other cited art -- fails to teach various aspects of the present claims as amended. Particularly, the present Office Action admits that earlier cited references have deficiencies¹ and attempts to overcome such deficiencies with the addition of *Akers*. Applicants respectfully submit that *Akers* fails to account for those deficiencies in contrast to the Office Action's assertions. Accordingly, Applicants maintain that the claims are allowable over the cited art even in view of *Akers*.

¹ With respect to the earlier cited references, Applicants reassert their earlier traversals and comments describing their various other deficiencies.

For example, *Akers* fails to support the Office Action's current assertion that *Akers* teaches "a central fill inventory which is remote from the first pharmacy prescription processing subsystem and dispensing a plurality of drugs from the central fill inventory via one or more shipments." *Present Office Action*, page 4. Specifically, the present Office Action relies on the "remote location" from paragraph 95 of *Akers* to reject "each prescription request in the queue eligible to be filled by a central fill inventory remote from the first pharmacy prescription processing subsystem" as recited in example Claim 1. For ease of reference, that paragraph is reproduced in its entirety below:

At 816, it is determined whether the patient has received this prescription before. If the patient is receiving the prescription for the first time, the method proceeds to 818 where remote counseling data is stored. The remote counseling data can include audiovisual data generated at a central site and at a remote site, where the patient is given advice on how and when to take the medicine and any questions that the patient has may be answered. The remote counseling data is stored in a manner that allows the data to be readily audited by legal authorities in order to verify that any legal requirements for dispensing pharmaceuticals are being followed. The method then proceeds to 820 where inventory count data is updated. The inventory count data can be used to track the number of remaining packages of pharmaceuticals at the remote location, the expiration dates of the packages, the rate of use of the packages, and other suitable data so that additional packages can be prepared and shipped as needed.

Akers, ¶ 0095. Applicants respectfully assert that the Office Action fails to read this cited portion of *Akers* within the context of the rest of FIGURE 8 of *Akers*.

Put simply, the Office Action asserts that *Akers*' remote location can act as the central inventory (**remote from the requesting pharmacy prescription processing subsystem**) that dispenses "a plurality of drugs from the central fill inventory via one or more shipments, the dispensed plurality of drugs associated with the plurality of filled prescription requests" as recited in Claim 1. But in direct contrast, *Akers* teaches that its remote location **is the pharmacy**. More specifically, *Akers* discloses that the asserted remote location is a telepharmacy that receives pre-packaged medicines for use in pharmacy services. For example, *Akers* (at FIGURE 8 and method 800) teaches that the prescriptions are pre-packaged into dosages at step 802, which are then transferred to the remote location at step 806 for subsequent dispensing. While they may be sent to the remote location because of low inventory, the pre-

packaged medicines include predetermined dosages and are only later matched up to a patient's prescription request. Such disclosures run counter to the Office Action's assertions:

- The Office Action first asserts that "it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Feeney in view of Bass with the aforementioned teachings from Akers [paragraph 95] with the motivation of having an enhanced means of storing pharmaceuticals as they are ordered (as they are needed) as recited in Akers (Section [0095])." *Present Office Action*, page 4. At this point, there is no mention by the Office Action of "shipping" from the remote location.
- Pages later, the Office Action attempts to explain this assertion: "Note: The Examiner takes the position that the '**remote location**' in Akers is run by a wholesaler who operates or manages the warehouse where the pharmaceuticals are stored." *Id.* at pg. 8 (emphasis added). But this position is in direct contrast to Akers' text. Namely, Akers' remote location acts as the pharmacy or some other location providing telepharmacy services: "[The remote site can be a facility that does not have a licensed practitioner onsite but which has personnel that have been trained to operate telepharmacy equipment or other suitable equipment." Akers, ¶ 0092. Clearly, if the remote location in Akers is the telepharmacy, it is not "a central fill inventory which is remote from the first pharmacy prescription processing subsystem" as recited in Claim 1.
- In an effort to further clarify this rejection, the Office Action then adds another note: "Note: Akers does not explicitly state that the pharmaceutical packages are shipped from the remote inventory site to the pharmacy or provider however [*sic*] this is a business practice well known in the pharmaceutical and health care industry and at the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the combined system of Feeney in view of Bass and Akers with the aforementioned business practice with the motivation of providing a means so that a pharmacy (provider) could provide a patient with counseling before the patient received their medication in case the remote counseling data taught in Akers was not available." *Id.* at pg 8-9. As shown above, the Office Action is correct that Akers "does not explicitly state that the pharmaceutical packages are shipped from the remote inventory site to the pharmacy" because Akers states that the remote location is the telepharmacy.

- Yet on the next page, the Office Action states that it would have been “obvious” to combine *Feeney-Bass* with *Akers* with the motivation of “having an enhanced means of storing pharmaceuticals and packaging and shipping them to the pharmacies as they are ordered (as they are needed) as recited in *Akers* (Section [0095]).” *Id.* at pg. 10 (emphasis added). In contrast to this new position, the Office Action admitted that *Akers* does not recite such shipments just pages before; this asserted motivation has no support the reference.²

Accordingly, the remote location in *Akers* can not be the asserted central fill inventory because it is the pharmacy and there is no indication that the pre-packager of the medicines processes prescription requests. In short, the Office Action admits that *Feeney* and *Bass* fail to show a central fill inventory that is remote from the pharmacy and dispenses drugs via shipments and there is no teaching, suggestion, or disclosure in *Akers* of any such central fill inventory “receiving the converted queue of prescription requests with the transmission format ... converting the queue of prescription requests from the transmission format to a processing format ... filling a plurality of prescription requests in the queue of prescription requests from the central fill inventory ... and dispensing a plurality of drugs from the central fill inventory via one or more shipments, the dispensed plurality of drugs associated with the plurality of filled prescription requests” as recited in example Claim 1.

For at least these reasons, Applicant submits that *Feeney* fails to teach, suggest, or disclose – indeed seems to teach against – certain aspects of the present claims. The other art cited in the rejections, such as *Akers*, fail to account for the deficiencies of *Feeney*. Accordingly, Applicant requests reconsideration and allowance of Claims 1-30.

² Moreover, the primary reference, *Feeney*, and the new reference, *Akers*, are directed at different technologies and provide no suggestion or other motivation to combine beyond the Office Action's incorrect assertion. *Feeney*'s professed “invention is generally directed to systems and methods for medical product dispensing and integrated information distribution and business management [and] relates to a medical system for integrating data management with the process of controllably dispensing products including medications” (*Feeney*, ¶¶ 25) and *Akers* purports to cover “a system and method for electronic medical file management are provided that overcome known problems with managing electronic medical files [and, in particular], a system and method for electronic medical file management are disclosed that provide for electronic medical file integrity and continuity, so as to prevent electronic medical files from being misfiled or tampered with” (*Akers*, ¶¶6-7). Even if the two references do include some suggestion or motivation to combine, *Feeney* specifically teaches away from such a combination for the various reasons outlined in previous responses. For example, *Feeney* repeatedly discusses the dispenser in terms of the doctor's office. Regardless, the *Akers-Feeney* combination fails to teach, suggest, or disclose various aspects of the present claims.

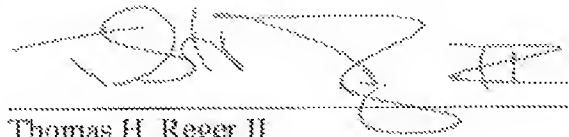
CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all Claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Applicants are enclosing with this Response a Petition for a One-Month Extension of Time. Please charge the \$60 extension fee and any other charges or credits to deposit account 06-1050.

Respectfully submitted,



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